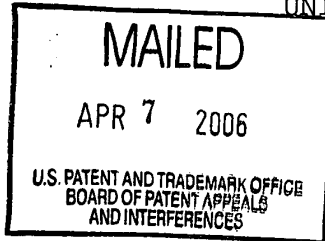


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MITSUNORI NODONO,  
RYUMA KURODA, TAKEO KITAYAMA,  
SATOSHI HANADA and SHIGEYOSHI MATSUBARA

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Appeal No. 2006-1178  
Application 09/635,141

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ON BRIEF

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Before KIMLIN, GARRIS, and WARREN, Administrative Patent Judges.  
GARRIS, Administrative Patent Judge.

REMAND TO EXAMINER

The above-identified application is hereby remanded to the examiner, via the Director for Technology Center 1700, for appropriate action consistent with our comments below.

The record for this application reflects that a Notice of Appeal was filed on June 17, 2004 from the examiner's final Office action mailed December 17, 2003 and, in particular, from

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the examiner's rejections of claims 6-8, 10-18, 28-31 and 48. On January 18, 2005, an Appeal Brief was filed addressing the aforementioned rejections. In response to this Brief, an Examiner's Answer was mailed on April 18, 2005. Significantly this Answer sets forth a new ground of rejection with respect to appealed independent claim 10 (see page 2, page 5, and page 8), and the Answer includes indicia of approval for this new ground of rejection by the Director of Technology Center 1700 (see page 10).

According to the electronic file record for this application, the appellants have failed to reply to the aforementioned new ground of rejection. In the Manual of Patent Examining Procedure (MPEP) at § 1207.03, V, C, "[i]f appellant fails to timely file a reply under 37 CFR 1.111 or a reply brief in response to an examiner's answer that contains a new ground of rejection, the appeal will be *sua sponte* dismissed as to the claims subject to the new ground of rejection" (page 1200-39; Rev. 3, August 2005). With respect to the circumstance before us wherein less than all of the appealed claims are subject to the

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new ground of rejection, this section of the MPEP provides the following guidance:

If only some of the claims under appeal are subject to the new ground of rejection, the dismissal of the appeal as to those claims operates as an authorization to cancel those claims and the appeal continues as to the remaining claims. The examiner must:

(1) Cancel the claims subject to the new ground of rejection; and

(2) Notify the appellant that the appeal as to the claims subject to the new ground of rejection is dismissed and those claims are canceled.

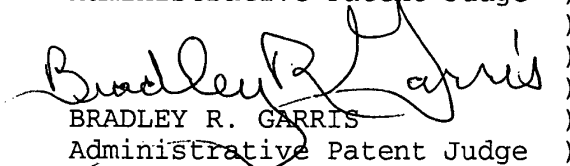
The electronic file record for this application additionally reflects that the examiner has failed to follow the above-discussed MPEP guidelines. In order to remediate this failure, we hereby remand the application to the examiner. To the extent necessary or desirable for effectuating this remediation, the examiner's response to this remand may include a Supplemental Examiner's Answer.

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This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01(D). It is important that the Board be promptly informed of any action affecting the appeal in this case.

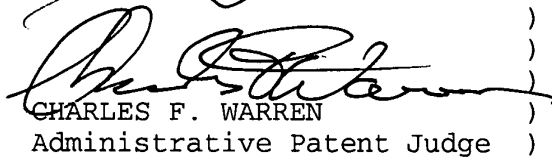


EDWARD C. KIMLIN )  
Administrative Patent Judge )



BRADLEY R. GARRIS )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES



CHARLES F. WARREN )  
Administrative Patent Judge )

BRG:psb

Appeal No. 2006-1178  
Application 09/635,141

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